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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/511,221

05/24/2005

Horst-Peter Antonicek

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3745

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EXAMINER

KOLKER, DANIEL E

ART UNIT

PAPER NUMBER

1649

MAIL DATE

DELIVERY MODE

09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,221

Applicant(s)

ANTONICEK ET AL.

Examiner

Daniel Kolker

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1 – 13, 18, and 21 – 22, and claim 24 to the extent it encompasses contacting cells or proteins with candidate compounds, drawn to proteins, nucleic acids encoding the proteins, vectors and host cells comprising the nucleic acids, methods of making protein, and methods of finding novel active compounds comprising contacting candidate compounds with protein or cells expressing the protein.

Group 2, claim(s) 14, drawn to an antibody.

Group 3, claim(s) 15 – 17, drawn to transgenic invertebrates and progeny of same.

Group 4, claim(s) 19, drawn to method of preparing a polynucleotide.

Group 5, claim(s) 20, drawn to method of generating a transgenic invertebrate comprising introducing a polynucleotide or a vector.

Group 6, claim(s) 23, drawn to a method of finding a chemical compound which alters protein expression.

Group 7, claim(s) 24, to the extent it encompasses antibodies, drawn to use of antibodies for finding novel compounds.

Group 8, claim(s) 24, to the extent it encompasses polynucleotides and vectors, drawn to use of polynucleotides and vectors for finding novel compounds.

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Group 9, claim(s) 24, to the extent it encompasses transgenic animals, drawn to use of transgenic animals for finding novel compounds.

Group 10, claim(s) 25, drawn to use a modulator of protein.

2. The inventions listed as Groups 1 – 10 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group 1 is directed to protein; the special technical feature is protein. Group 1 includes claims drawn to proteins, as well as methods of making protein (i.e. claim 18), and the first method of using protein (claims 21 – 22 and claim 24 to the extent it encompasses protein). As a courtesy to applicant, the examiner has also included claims drawn to nucleic acid encoding the protein, as well as vectors and host cells comprising same. Groups 2 – 3 are drawn to different products with different technical features. The technical feature of group 2 is an antibody; the technical feature of group 3 is an invertebrate animal, each of which is distinct from protein. Groups 4 – 5, 7, and 9 are drawn to methods of using these products. Group 10 is drawn to a modulator, which is structurally distinct from the protein of group 1. As the products do not share the same or corresponding technical feature with group 1, the methods of using those products do not share the feature either. Groups 6 and 8 are drawn to different methods of using the products of group 1. Note that PCT Rule 13 does not allow for multiple patentably distinct products or methods in a single application. Because the special technical feature of Group 1 is not present in the claims of Groups 2 – 5, 7, and 9 – 10, and because groups 6 and 8 are drawn to different methods of using the products of group 1, unity of invention is lacking.

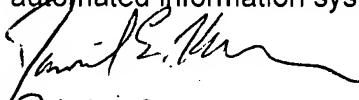
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kolker whose telephone number is (571) 272-3181. The examiner can normally be reached on Mon - Fri 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patent Examiner

Daniel E. Kolker, Ph.D.

September 20, 2007